

REMARKS

Claims 1-3, 5-26, 28-55 and 58-79 are pending in the present application. Claims 3, 5, 7, 10, 16, 28, 40-55 and 58-64 were withdrawn from consideration. By virtue of this response, claims 8, 9, 11, 15 and 74-77 have been cancelled and claims 12, 17, 20, 29, 33, 35 and 39 have been amended. Accordingly, claims 1, 2, 6, 12-14, 17-26, 29-39, 65-73, 78 and 79 are currently under consideration.

Amendment and/or cancellation of the claim listed above are not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented. Moreover, it is not to be construed that Applicant has acquiesced to any rejections made by the Patent Office. Applicant expressly reserves the right to pursue prosecution of any presently excluded subject matter of claim embodiments in one or more future continuation and/or divisional application(s).

Response to Amendment

Applicant acknowledges that the rejection of claims 30 and 32 under 35 U.S.C. 112, first paragraph and the rejection of claim 1 under 35 U.S.C. 102(a) as being anticipated by Nielsen et al. have been withdrawn in view of Applicant's amendment filed on February 9, 2009.

Claim Rejections – 35 USC § 102

Claims 8, 9, 11, 15, 17, 20, 22-25, 29, 33, 35, 37, 39, 65-72, and 74-77 stand rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Reddy et al. (WO 99/53047, "Reddy").

Without acquiescing to the rejection and solely to expedite prosecution, Applicant has canceled claims 8, 9, 11, 15, and 74-77. Applicant has amended claims 17, 20, 29, 33, 35, and 39 to depend from claim 12, which the Examiner has found allowable. The remainder of the claims ultimately depends from allowed claim 12.

Anticipation requires that each and every element be taught by the cited reference. MPEP 2131. Applicant submits that 17, 20, 22-25, 29, 33, 35, 37, 39, 65-72, presented herein, are not anticipated by Reddy since Reddy does not disclose each and every element of the claimed invention.

In view of the foregoing, Applicant respectfully requests that the Examiner withdraw this Section 102(b) rejection of the claims.

Claim Rejections – 35 USC § 103

Claim 73 stands rejected under 35 U.S.C. 103(a) as allegedly being obvious over Reddy et al. (WO 99/53047, “Reddy”) as applied to claim 8, 11, 39, 67, and 72 above, and further in view of Letchworth, III et al. (US Patent 5,462,734, “Letchworth”).

Applicant traverses this rejection of the claims. By virtue of this response, claim 73 depends from independent claims 12, 18, 19 and 26; all of which the Examiner has found allowable. Claims 12, 18 and 19 are directed toward recombinant adenovirus vectors comprising the precise PAV3 encapsidation region and heterologous adenoviral sequences. Claim 26 is directed toward recombinant porcine vectors which comprise a deletion of a part of the porcine adenovirus sequence essential for encapsidation.

Reddy does not teach or suggest the precise region of PAV3 responsible for encapsidation, much less heterologous adenoviral vectors comprising the precise PAV3 encapsidation region or PAV3 vectors comprising deletions of the PAV3 encapsidation region. The Letchworth reference does not cure the deficiencies of Reddy because the Letchworth reference has no teachings at all of adenovirus vectors, much less the precise region responsible for PAV3 encapsidation. As such, the combination of Reddy and Letchworth does not provide any teaching or suggestions that would allow one of skill in the art to have a reasonable expectation of success for the presently claimed invention. Therefore, claim 73 is not obvious in view of the cited references.

In view of the foregoing, Applicant respectfully requests that the Examiner withdraw this Section 103 rejection of claim 73.

Double Patenting

Claims 8, 9, 11, 15, 17, 20, 22-25, 29, 33, 35, 37, 39, 65-68, 70, and 72 remain rejected on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 13-17 and 19-23 of U.S. Patent No. 6,492,343 (hereafter referred to as the “’343 patent”).

Applicant traverses this rejection of the claims. Without acquiescing to the rejection of the claims and in an effort to expedite prosecution, Applicant has canceled claims 8, 9, 11, 15, and 74-77. Applicant has amended claims to depend from claim 12, which the Examiner has found allowable. Claim 12 relates to a replication-defective recombinant adenovirus vector which comprises a porcine adenovirus sequence essential for encapsidation, wherein said sequence essential for encapsidation consists of the nucleotide sequence between nt 212 and 531 (SEQ ID NO:414) of porcine adenovirus type 3, wherein said nucleotide sequence comprises the sequence TATTTTTT, wherein the nucleotide sequence is capable of encapsidating an adenovirus genome, and wherein said porcine adenovirus sequence essential for encapsidation is heterologous to said adenovirus vector.

The ‘343 patent discloses the genomic sequence of porcine adenovirus 3 (PAV3). However, one of skill in the art cannot look at a genomic sequence of a viral sequence, particular one with overlapping transcription sequences and be able to pinpoint precisely where an encapsidation sequence would begin or end. The PAV3 encapsidation sequences disclosed in the instant specification overlaps with the E1 transcription start site. Thus, without the knowledge disclosed by the instant specification, one of skill in the art runs the risk of interfering with E1 transcription and its resultant consequences. The ‘343 patent does not teach or suggest the precise region of PAV3 responsible for encapsidation, much less the use of the precise PAV3 encapsidation region in a heterologous adenovirus. Furthermore, it does not teach or suggests the motifs for the sequence required for encapsidation. As such, the ‘343 patent does not provide any teaching or

suggestions that would allow one of skill in the art to have a reasonable expectation of success for the presently claimed invention. Therefore, claims 17, 20, 22-25, 29, 33, 35, 37, 39, 65-68, 70, and 72 are patentably distinct from claims 13-17 and 19-23 of the '343 patent.

In view of the foregoing, applicants respectfully request that the examiner withdraw this nonstatutory obviousness-type double patenting rejection.

Request for Rejoinder

Pursuant to MPEP §821.04(b), Applicant respectfully requests rejoinder of claims 40 and 41, which are directed to methods eliciting an immune response in a mammalian subject comprising administering compositions of claims 35 or 36. Amended claim 35 depends from claims 12, 18 and 19; all of which have been found allowable by the Examiner. Claim 36 has also been found allowable by the Examiner. In addition, pursuant to MPEP §821.04(b), Applicant respectfully requests removal of the restriction between the elected product and process(es).

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 293102003600. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: July 2, 2009

Respectfully submitted,

Electronic Signature: /Terri Shieh-Newton/
Terri Shieh-Newton

Registration No.: 47,081
MORRISON & FOERSTER LLP
755 Page Mill Road
Palo Alto, California 94304-1018
(650) 813-5777